REMARKS

I. Introduction

In response to the Office Action dated September 9, 2005, Applicants respectfully submit that the pending claims are patentable over the cited prior art references for the reasons set forth below. Applicants request reconsideration of the pending rejection in view of the following comments.

II. The Rejection Of Claims 1-18 And 21-26 Under 35 U.S.C. § 103

Claims 1-18 and 21-26 were rejected under 35 U.S.C. § 103 as being obvious over USP No. 5,331,419 to Yamada in view of USP No. 5,317,508 to Okamoto. For the following reasons it is clear that the combination of Yamada and Okamoto fails to present a *prima facie* case of obviousness.

Claim 1 recites in-part "an image synthesizer which generates a scale image ... in accordance with ***three-dimensional*** positional information of the object and for ***combining*** the scale image with the image of the object."

In the pending rejection, it is acknowledged that Yamada fails to disclose the use of three dimensional positional information of the object or combining the scale image with the image of the object. Okamoto is relied on a curing the deficiencies of Yamada. However, Okamoto clearly fails to do so.

More specifically, contrary to the conclusion set forth in the rejection, Okamoto does not appear to disclose the use of three dimensional positional information in any manner. Indeed, it does not appear that the term "three dimensional" is even recited in the specification of Okamoto. Further, all of the drawings of Okamoto only disclose the use of two dimensional

coordinates (x,y) (*see*, for example, Fig. 14). In addition, again contrary to the conclusion in the pending rejection, the disclosure at col. 14, lines 10-68 of Okamoto does not appear to disclose combining the scale image with the object image. Thus, even if the references were properly combinable, the combination of Yamada and Okamoto still fails to disclose the claimed invention as recited by the pending claims for at least the foregoing reasons.

As each and every limitation must be disclosed or suggested by the prior art references in order to establish a *prima facie* case of obviousness (*see*, M.P.E.P. § 2143.03), and the combination of Yamada and Okamoto fails to do so for at least the foregoing reasons, it is clear that the pending claims are patentable over Yamada and Okamoto, taken alone or in combination with one another.

III. All Dependent Claims Are Allowable Because The Independent Claims From Which They Depend Are Allowable

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co., 819 F.2d at 1100, 1108 (Fed. Cir. 1987).* Accordingly, as independent claims 1, 10, 18 and 23 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also in condition for allowance.

IV. Conclusion

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Michael E. Fogarty
Registration No. 36,139

Please recognize our Customer No. 20277 as our correspondence address.

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 MEF/rp
Facsimile: 202.756.8087
Date: December 9, 2005

WDC99 1171861-1.060188.0425